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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/103,745	06/24/98	AGRAWAL	S 475.08.642CI

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HM12/0606

EXAMINER

WANG, A

ART UNIT	PAPER NUMBER
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1635

*8*

DATE MAILED:

06/06/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

FILE COPY

**Office Action Summary**Application No.  
**09/103,745**

Applicant(s)

**Agrawal**

Examiner

**Andrew Wang**

Group Art Unit

**1635**☒ Responsive to communication(s) filed on Mar 9, 2000☒ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 1-4 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 1-4 is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. The request filed on March 9, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/103,745 is acceptable and a CPA has been established. An action on the CPA follows.

2. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,856,462 for the same reasons of record as set forth in the Office action mailed September 9, 1999.

Applicants have not provided any arguments addressing the rejection of record.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the same reasons of record as set forth in the Office action mailed September 9, 1999.

Applicants have not provided any arguments addressing the rejection of record.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the reduced side effects for the CpG oligos having the modifications listed in claim 1 and/or shown in Example 2, does not reasonably provide enablement for CpG oligos

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having simply phosphorothioate linkages as in claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims for the same reasons of record as set forth in the Office action mailed September 9, 1999.

Applicants have not provided any arguments addressing the rejection of record.

5. Claims 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods in cells in culture and for reduced side effects for the CpG oligos having the modifications listed in claim 2 and/or shown in Example 2, does not reasonably provide enablement for methods in whole organisms and for CpG oligos having simply phosphorothioate linkages as in claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims for the same reasons of record as set forth in the Office action mailed September 9, 1999.

Applicants have not provided any arguments addressing the rejection of record.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Krieg *et al.* (WO 96/02555 or Antisense or Nucleic Acid Drug Devel.) for the same reasons of record as set forth in the Office action mailed September 9, 1999.

Applicants have not provided any arguments addressing the rejection of record.

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7. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Krieg *et al.* (Nature) for the same reasons of record as set forth in the Office action mailed September 9, 1999.

Applicants have not provided any arguments addressing the rejection of record.

8. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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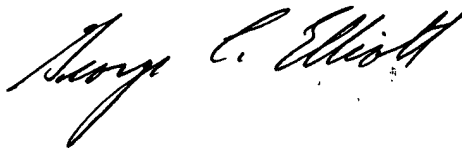
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Wang whose telephone number is (703) 306-3217. The examiner can normally be reached on Monday to Thursday from 7:00 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached on (703) 308-4003. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Andrew Wang  
May 30, 2000

Andrew Wang  
Patent Examiner  
Technology Center 1600



George C. Elliott, Ph.D.  
Supervisory Patent Examiner  
Technology Center 1600